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EXAMINER

INYARD, APRIL C

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/531,465	BEIER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	APRIL C. INYARD	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 26-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This second non-final action is in response to the amendments filed on 04/03/09.

1. The Examiner acknowledges amendments to Claims 1, 5-6, 12-13, 16, 18-23, 26-28, 30, 32, and 35-36; and cancellation of Claims 24-25.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-23 and 26-36 are pending and have been considered as follows:

#### ***Response to Amendment and Examiner's Notes***

4. The objection(s) to Claims 1 and 30 are withdrawn in view of Applicant's amendments to the claims.
5. The rejection(s) of **Claims 1, 5, 6, 9, 18, 28, 30, and 32** are rejected under 35 U.S.C. 112, first paragraph is withdrawn as the Applicant has made it of record that they agree with the Examiner's interpretation of the terms "lacquer", "UV lacquer" or "non-stick lacquer" of the instant claims, where a skilled artisan would appreciate that a lacquer in the most general sense is any resinous material that is typically applied to the surface of an object as either a protective coating or as an adhesive. Further, it would be obvious to a person having ordinary skill in the art that the general term "lacquer" or "non-stick lacquer" includes a wide variety of solvent-based solutions that could essentially form a plastic-like thin-film or sheet coating on a surface, e.g. multiple polyurethane coatings. A skilled artisan would understand that this could mean a lacquer that either cures by UV radiation or a lacquer that absorbs ultraviolet energy to promote

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weatherability of a surface to which the lacquer layer is applied. Therefore, these terms are interpreted broadly by the Examiner as would be understood by one of ordinary skill in the art to mean any type of layer that may either cure by UV radiation or absorb UV rays, and that may impart a non-stick and/or adhesive feature to the assembly. For example, a plastic sheet layer could be formed from a lacquer having the aforementioned properties, as could an adhesive layer could be interpreted as a lacquer.

6. The Examiner notes that Applicant's use of the term "scratch label" is not closed language, and interprets this to mean that such a label include any amount of additional layers so long as one of them is a scratch-off type of layer.

### ***Claim Objections***

7. **Claim 5** is objected to because of the following informalities: Applicant's amended claim 5 to clarify the objections previously made of record, where the term "upper" was deleted. In the last line of Claim 5, Applicant refers back to "the upper ink layer", where the term "upper" was deleted upon amendment. The Examiner understands that Applicant is referring to "the ink layer" but should delete the additional term "upper" from the last line to avoid confusion and any future improper antecedent basis rejections. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

8. **Claims 1-2, 4-5, 7-9, 12, 21, 23, 26-29 and 35-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Annacone et al. (US Pub. 2002/0020739 A1).**

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**Regarding Claims 1 and 28,** Annacone teaches a multilayered security label assembly as shown in Figures 8A and 12H (elements 52 and 37) below:

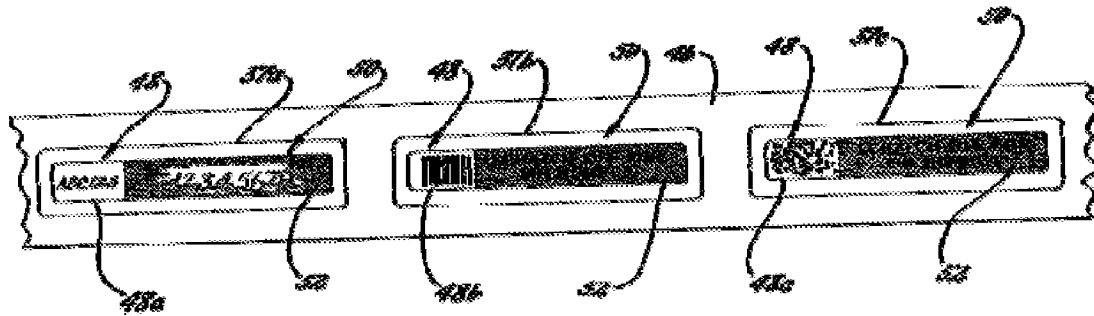


FIG. 8A.

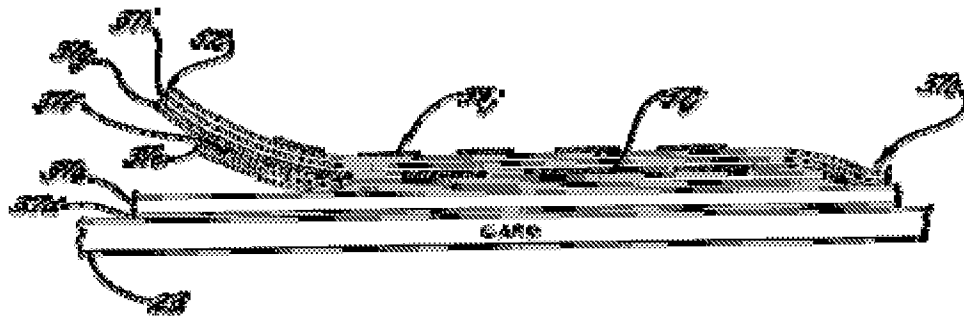


FIG. 12H.

Regarding Fig. 8A, Annacone discloses that the security label has a control code field (48) and a PIN code field (50), where the PIN code field (50) is covered with a scratch-off layer formed as a paint or other similar coating (52) that can be scratched-off, and where the control code field can be a variety of information used to identify the security label and is thus not covered and left exposed on the base label layer (*pars.* [0040]-[0041]).

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Regarding Fig. 12H, the security scratch-off label has (*pars.* [0043]-[0048]):

(a) a base layer made (37a)

(b) an opaque, releasable film layer (37b) positioned directly thereon, which could be formed as a plastic film (37e) and ink (37f) or as a first releasable ink layer followed by an additional opaque ink layer or series of ink layers

(c) a PIN printed on the opaque, releasable film layer at the PIN number field (37j), and a scratch-off layer (52) to cover and obscure the PIN.

Annacone discloses that upon application of a peeling force to remove the scratch-off cover layer, such as by lifting the scratch-off cover label, the opaque, releasable film layer (37b) is removed and hides the printed PIN from viewing via its backside because the film layer (37b) is opaque and thus provides enhanced security, where such a security label can either be manufactured as a separate label unit to be positioned on a separate carrier web or can be manufactured on a base substrate such as a telephone calling card directly (*par.* [0044]).

The Examiner notes that the security label of Annacone may be interpreted in two ways:

(1) the security label taught by Annacone is itself is a value document as it contains protected information to be secured.

(2) insomuch as Annacone teaches that such labels can be manufactured directly onto a card surface, this would not require the adhesive layer (37d) or base label layer (37a) if the security scratch-off label layer taught by Annacone are directly manufactured onto a card because Annacone teaches that the scratch-off label can be applied as component parts serially, as in application of the opaque releasable label strip, followed by code printing, the second label strip and/or the scratch-off layer (*par.* [0061]).

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If interpreted according to (1), Annacone teaches a security label which interpreted to correspond to Applicant's "value document".

If interpreted according to (2), the card itself is interpreted to correspond to Applicant's "value document".

Opaque, releasable film layer (37b, comprised of 37e and 37f) of Annacone therefore corresponds to Applicant's additional layer comprising an ink or lacquer disposed direction on the value document (either the base label layer (37a) if interpreted according to (1), or the card if interpreted according to (2) if the label is manufactured directly on the card material).

Likewise the PIN code (37j) and scratch-off (52) layers of Annacone correspond to Applicant's claimed information to be secured between the additional layer and scratch-off layer.

Regarding the limitation that the scratch label has a base area smaller than the value document, if interpreted according to (1), as shown in Fig. 8A, the scratch-off region (50, 52) has a smaller area than the total security label area, where the security label itself is the value document; and if interpreted according to (2), the scratch-off assembly (layers 37e, 37f, 37i, 37j, 52) has a smaller area than the card upon which it may be directly manufactured onto.

Therefore Annacone clearly teaches an assembly and a method for producing an assembly that meet the limitations of instant **Claims 1 and 28**.

Regarding **Claims 12, 23, 26-27, 29 and 35-36**, as discussed above, Annacone clearly teaches that the additional layer (37b comprised of layers 37e and 37f) has an adhesive strength with a greater affinity for the scratch-off layer than the base layer (whether interpreted according to (1) or (2) above), that the additional layer is formed on the base layer (whether on the base label layer (37a) or directly on the card) is in a size of an information field that is the size of the

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information to be secured, that the scratch-off layer (52) has a larger base area than the additional layer (*see Fig. 12H above*), and that the information to be secured is a PIN number.

**Regarding Claims 2, 4, 7-8, 34**, Annacone discloses that the information to be secured is printed on the additional ink layer by an ink jet process onto an opaque white ink part of the releasable film layer (*par. [0047]*). The opaque white releasable layer (37b) as taught by Annacone may be made of a plastic film (37e) and opaque white ink (37f) or may be a first and second or series of opaque ink layers (*pars. [0046]-[0047]*). Thus, an opaque white releasable film ink layer is a monochrome ink that will provide contrast to the information provided thereon when viewed from the top side.

Regarding **Claims 5 and 9**, Annacone discloses that the additional layer can be more than one layer comprising at least one ink layer (37f) and at least one further layer that may be either a “lacquer” layer (plastic, 37e) or ink layer or series of ink layers disposed between the object and the ink layer (*par [0046]*).

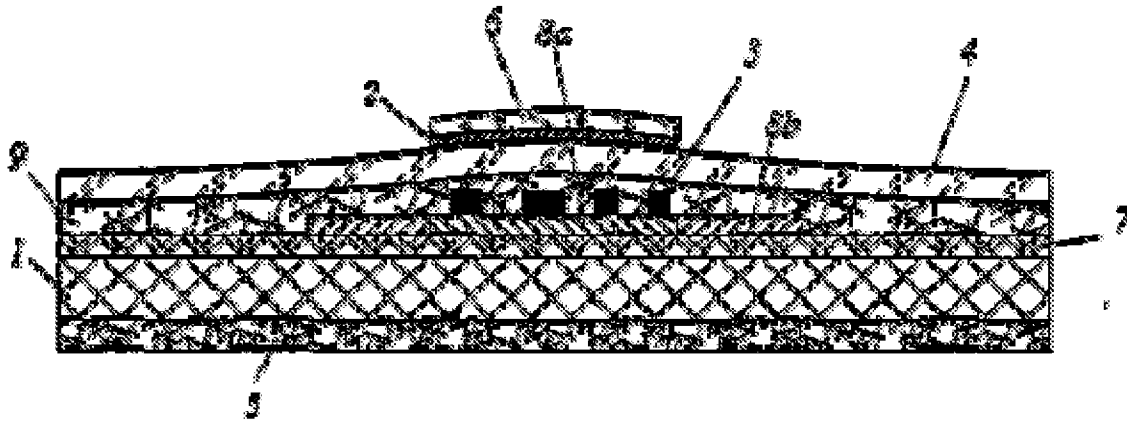
Regarding **Claim 21**, Annacone teaches that the additional layer can be formed from an ink layer that is opaque and releasable (*par. [0046]*) and can be printed on the object (*par. [0061]*).

9. **Claims 1, 4-8, 23, 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleischauer et al. (DE 10109964 A1).**



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(Claims 1, 4-8, 23, 25-28) Fleischauer ('964) teaches an assembly security sticker shown in Fig. 1 below:



(Claims 1, 4, 8 and 12) Fleischauer ('964) teaches that the security label secures information such as coding and pin codes (*page 1, par. 2*) and is applied to an object (*page 1, pars. 2 and 4--documents and motor vehicles*) where the information to be secured is printed (*page 2, par. 6; Fig. 1--information layer 3*) on an additional ink or lacquer layer that is a size of the information field to be secured (*page 2, par. 6; Fig. 1--rear dye film 8 and retroreflective coating 7, interpreted to be a lacquer*) an object or base layer (*page 2, par. 6, Fig. 1--layer 1*) wherein the color of the additional layer is specifically selected to contrast the color of the information printed thereon (*page 2, par. 6*) and the adhesive strength of the additional layer to the cover sticker, which is an adhesive label having a base area larger than the additional layer (*Fig. 1—layers 2, 4 and 6 are cover sticker, layer 9 is adhesive*) is greater at least in partial areas than the adhesive strength of the additional layer to the object (*page 2, par. 2*).

(Claim 5) Fleischauer ('964) further teaches that the additional layer is formed by a multi-ply layer and comprises at least one ink layer (*Fig. 1, dye film 8a and 8b*) and at least one

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further lacquer layer (*Fig. 1, retroreflective coating layer 7*) disposed between the object (*Fig. 1, base film 1*) and the ink layer.

(**Claim 6**) Fleischauer ('964) teaches that the assembly should preferably be UV stable so that it does not become destroyed by sun exposure (*page 2, par. 4*) and thus teaches use of UV stable components such as UV lacquer.

(**Claim 7**) Fleischauer ('964) teaches the ink layer located under the information is formed by a monochrome ink layer (*Fig. 1—dye film 8a located under information layer 3; page 2, par. 6*).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Claims 3, 6, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Annacone et al. (US Pub. 2002/0020739 A1).**

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Regarding **Claim 3**, as discussed above, Annacone discloses an assembly that meets the limitations of Claim 1.

Annacone further teaches that the additional layer is preferably an opaque white color (*par. [0047]*).

Annacone does not specifically teach use of a black ink for printing the information to be secured on the additional layer.

However, at the time of the invention, it would have been obvious to one having ordinary skill in the art to use a black ink for printing on the opaque white layer taught by Annacone because this is not only one of the most commonly used and readily available pigments, but a skilled artisan would recognize that black ink on an opaque white background is optimal for clarity and discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA1947).

Regarding **Claim 6**, as discussed above, Annacone teaches an assembly that meets the limitations of Claim 5.

Annacone does not specifically disclose the use of a UV lacquer.

However, as previously made of record, the Examiner gives the term “UV lacquer” its broadest reasonable interpretation, where one of ordinary skill in the art appreciate that the “releasable plastic film” taught by Annacone could be cured by UV radiation or be a plastic that absorbs UV light. Utilization of UV-curable and/or UV-absorbing plastics is replete in the art,

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and it would be obvious to a skilled artisan to choose a suitable material for plastic film taught by Annacone for the intended application as a matter of obvious engineering choice. *In re Leshin*, 125 USPQ 416.

Regarding **Claims 10-11**, as discussed above, Annacone discloses an assembly that meets the limitations of Claim 9.

Annacone does not specifically teach that the second ink layer either has an irregular pattern (Claim 10) or contains blind information whose character corresponds to the information to be secured (Claim 11).

However, as Annacone discloses that the purpose of the ink layers is to obscure or conceal the secured information such that the information cannot be viewed from the backside if the label is removed (*par. [0009]*), it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the second ink layer with an irregular pattern or with blind information as both of these design choices would achieve the same purpose taught by Annacone, which is to conceal the secured information, and it has been held that the configuration was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration claimed was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

13. **Claims 13-20, and 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Annacone et al. (US Pub. 2002/0020739 A1) or Fleischauer et al. (DE 10109964 A1) in view of Pekko (US Patent No. 3,631,617).**

**(Claims 13-20, 30 and 32)** Annacone and Fleischauer each disclose an assembly that meet the limitations of Claims 1 and 28.

Neither Annacone nor Fleischauer specifically describe a differential adhesive strength of the additional layer to the cover sticker and object in first and second areas.

However, it is replete in the tamper-proof labeling art to provide areas with differential adhesive strengths such that upon removal of said label, the label is torn along the path of least resistance.

One teaching of use of a differentially adhesive layer as a tamper-proof and/or security mechanism is disclosed by Pekko, who teaches a multi-layered tamper-proof label having an adhesive base, and a masking film sandwiched between the adhesive base and a self-supporting film, wherein information may be printed on the top or underside of the self-supporting film, on the top side of the masking film, or both; and the adhesiveness of the masking film to the base adhesive layer is greater than to the self-supporting film because of limited or partial adhesivity to the self-supporting film, or because of the presence of a release coating such that when the self-supporting film is removed, all or part of the information and masking film will remain on the base adhesive (*Figs. 1-3; Col 3, lines 11-41*). Pekko further teaches that the structure of the differentially adhesive areas can be fine-scale or irregular (*Fig. 3*).

Additionally, Pekko discloses that differential adhesion of the masking layer to either the base adhesive or the self-supporting film may be achieved by application of “non-stick lacquers” (*Col 3, line 18*), partial application of an adhesive (*Col 3, lines 16-17*), and application of printable inks known to have poor adhesive affinity for the self-supporting film (*Col 3, lines 18-27*), and likewise the self-supporting film may be treated in specific portions to be more

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compatible and adhere to areas of the masking film (*Col 3, lines 29-41*) such that when the cover sticker is removed, the information to be secured will be destroyed and reduce the ability to be counterfeited (*Col 2, lines 25-27*).

At the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the assembly taught by either Annacone or Fleischauer to include areas of differential adhesion of the additional layer to the object and cover sticker in either a fine-scale or irregular structure achieved by adjusting the adhesive strength through use of adhesion promoters or “non-stick lacquers” by printing as taught by Pekko because this feature provides an additional security and tamper-proof advantage.

Additionally, as discussed above, the Examiner notes that Annacone teaches that the additional layer is an opaque printed ink that preferentially adheres to the scratch-off label when tampered with to obscure the information from being viewed from the underside.

However, an alternative method to protect and prevent sensitive information from being tampered with and stolen is to use differential adhesives as taught by Pekko to separate the layers in an irregular or fine-scale pattern that will destroy the protected information and likewise prevent one from viewing protected information.

It would therefore further have been obvious to one having ordinary skill in the art at the time the invention was made to modify the additional lacquer layer taught by Annacone by simple substitution of one known layer used for the protection of secure information, an opaque layer that has a greater adhesive strength to the scratch-off cover sticker to conceal and prevent unwanted viewing of protected information, for another, a differentially adhesive layer that tears protected information along an irregular or fine-scale pattern to destroy and prevent unwanted

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viewing of protected information as taught by Pekko, as both of these layers are known functional equivalents in the art of protecting and preventing unwanted viewing of secure information.

**14. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Annacone in view of Pekko and Fleischauer.**

**(Claim 31)** As discussed above, Annacone in view of Pekko teaches the method of making an assembly that meets the limitations of Claim 30.

Annacone teaches that the additional layer can be a series of ink layers (*par* [0046]).

Annacone refers to the series of ink layers as “different inks” (‘739; *par*. [0050]) and discloses the printing of additional indicia or patterns that are different than the other ink layers on the top of a scratch-off layer (‘739; *Fig. 12H: labeled element 37j on top of scratch-off layer 52; par*. [0048]).

Annacone does not specifically teach that these additional ink layers are different colors and/or patterns.

However, Fleischauer teaches use of a different colored inks (*Fig. 1—dye films 8a and 8b*), where ink layer 8a provides contrast to the protected information (3) printed thereon, and ink layer 8b is a different color and can be printed with such information as a brand, logo, or emblem because it can be viewed through the transparent cover layer (4) (*p. 2, pars. 1 and 6*).

It would have therefore been obvious to one having ordinary skill in the art to modify the additionally ink layer or series of ink layers taught by Annacone with the differently colored or patterned ink layers as taught by Fleischauer because using an ink that has a different color than

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that provided beneath the protected information allows for various designs and patterns to be printed in order to customize the security label, and further, as Annacone teaches a control code field (48) area (*see above*) of the label that contains unsecured identifying information, it would have been obvious to the skilled artisan that such a region would require use of various colors of ink.

**15. Claims 22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Annacone et al. (US Pub. 2002/0020739 A1) in view of Feilen et al. (US Pub. 2002/0028321 A1).**

As discussed above, Annacone discloses an assembly and method that meet the limitations of Claims 21 and 28 as discussed above.

Annacone does not specifically teach that the additional layer is printed on the object by an offset process.

First, however, Annacone specifically teaches that the information to be protected is ink jet printed (*see above*) but does not particularly state the method by which the additional layer is printed. Moreover, Annacone specifically teaches that the additional layer is an opaque white ink and teaches printing of a scratch-off layer to conceal the sensitive information (*see above*). The Examiner therefore interprets the teaching of Annacone broadly in that the opaque white ink additional layer may be printed using any process known in the art.

Second, Feilen teaches a method of offset printing, particularly in the context of printing scratch-off ink layers and high quality single and multiple layers of different colored scratch-off material (*Abstract; pars. [0003], [0006]-[0007] and [0013]*). Feilen discloses that offset



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printing is often used in applications such as lottery tickets that contain information that is to be secured (*par. [0004]*). Furthermore, Feilen teaches that it is known in using the offset process to print such types of material, UV lacquer layers are commonly used as primer layers applied over the object (*par. [0014]*).

Annacone discloses the claimed invention except for use of the offset printing process for the additional layer. However, as Annacone discloses use of an opaque white ink for the additional layer and does not specifically teach how the printing of this layer on the object is achieved.

It would have therefore been obvious to one having ordinary skill in the art at the time the invention was made to modify the printing of the additional opaque white ink layer taught by Annacone by using an offset printing process as taught by Feilen because this is a known printing method that is commonly used for printing UV lacquer layers or primer layers, which corresponds to the additional layer of Annacone; and additionally, this method is commonly used for application of opaque inks such as scratch-off inks and has advantages that include reduced labor and equipment costs, increased efficiency and is a more automated printing process.

**16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischauer et al. (DE 10109964 A1).**

Regarding **Claim 3**, as discussed above, Fleischauer teaches use of an ink color beneath the information to be protected in order to provide contrast.

Therefore, it would be obvious to one having ordinary skill in the art to use a black ink for the information layer as black stands out on most backgrounds that provide contrast.

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**17. Claims 2, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischauer et al. in view of Annacone.**

Regarding **Claims 2 and 9-11**, as discussed above Fleischauer and Annacone each teach an assembly that meets the limitations of Claim 1.

Fleischauer teaches that the information is laser printed and a second ink layer that is a different color from the first ink layer (*Fig. 1, dye layer 8b; page 2, par. 6*)

Fleischauer fails to specifically teach that this ink layer is disposed between the further lacquer layer and the ink layer under the information and that it is inkjet printed.

However, Annacone discloses a series of ink layers beneath the ink jet printed information layer (*see above*).

At the time of the invention it would have been obvious to one having ordinary skill in the art to ink jet print the information as taught by Annacone instead of laser print the information as taught by Fleischauer as a matter of engineering choice. As Fleischauer and Annacone teach similar processes and structures to the instant claims. It has been held that where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

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Furthermore, it would have been obvious to a skilled artisan at the time the invention was made to place the additional second ink layer of a different color taught by Fleischauer beneath the information layer as taught by Annacone because a skilled artisan would recognize that this adds to the security properties of the assembly and it would simply require a rearrangement of the layers taught by Fleischauer which is held to involve only routine skill in the art. *In re Japikse*, 86 USPQ 70.

### ***Response to Arguments***

18. Applicant's arguments with respect to claims 1-23 and 26-36 have been considered but are moot in view of the new ground(s) of rejection.

19. The Examiner points out that as rejection of Claims 1,5, 6, 9, 18, 30, and 32 under 35 USC 112, first paragraph, have been withdrawn, that as made of record in the Examiner's Notes section above, the Applicant agrees on p. 9 of the remarks with the Examiner's interpretation of the terms "lacquer", "UV lacquer", or "non-stick lacquer", which are given their broadest reasonable interpretations as would be understood by one having ordinary skill in the art.

20. Regarding the rejection of the claims under 35 USC 102(b) as anticipated by Annacone, the Applicant's agree with the Examiner on p. 9 of the remarks that Annacone teaches Applicant's claimed scratch-off label structure. However, the Applicant's primary argument regarding the rejection is that Annacone fails to teach an additionally layer "directly on a value document".

The Examiner thanks the Applicant for pointing this out. These rejections are now clarified such that the teachings of Annacone may be interpreted in two different ways. Either

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interpretations clearly illustrates that Annacone not only anticipates Applicant's claimed label structure, but further discloses the deposition of the additional layer directly on the value document whether the "value document" is interpreted to be the security label itself, as a security label contains valuable information; or as the label disposed on an identification or telephone card, where the Examiner clearly points out that although Annacone teaches that one method for labeling a card is through an automated labeling process, Annacone also discloses that such label structures may be directly printed onto a card surface as a sequential layering process which eliminates the need for a base label layer and adhesive.

Therefore, in view of the newly made and clarified rejections, the Examiner maintains the rejections of **Claims 1-2, 4-5, 7-9, 12, 21, 23, 26-29 and 35-36** under 35 U.S.C. 102(b) as anticipated by Annacone.

21. Regarding the rejection of the claims under 35 USC 102(b) as anticipated by Fleischauer, the Applicant first argues that layer 7, the retroreflective layer, taught by Fleischauer is not an additional "ink or lacquer" layer that is disposed "directly on a value document".

The Examiner respectfully disagrees. As made of record in the prior and current office action, the Examiner clearly points out that the retroreflective layer taught by Fleischauer, which is distinctly disposed directly on the value document layer (1), is considered to correspond to the Applicant's "additional layer". As discussed above, the Examiner interprets Applicant's term "lacquer" in the broadest sense, and therefore as would be understood to one having ordinary skill in the art, a retroreflective layer reads on "lacquer", particularly given that the skilled artisan would recognize that a retroreflective layer could either contain an ink with reflective properties

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or particles, or a binder (lacquer) with reflective particles. Additionally, given that the Applicant has neither provided arguments or evidence to show or explain why a retroreflective layer is not a lacquer layer, the Examiner maintains that the retroreflective layer of Fleischauer reads on Applicant's claim to an additional layer comprising an "ink or lacquer" disposed directly on a value document.

Applicant next argues that Fleischauer fails to teach any adhesive strength between the additional layer and the scratch label. Applicant further argues that the intermediate layer (4) of Fleischauer separates the scratch-off label from the ink layer (8 a, b), and thus are not in direct contact with one another. As presently claimed, neither the ink layers nor the additional layer are required to be in direct contact with the scratch layer, but are only required to have a preferential adhesiveness for the scratch label at least in partial areas.

The Examiner respectfully disagrees. It appears that from the prior office action, the Applicant interpreted the additional layer of Fleischauer as the ink layers (8 a,b). However, as made clear in the prior and current office action, the retroreflective layer (7) of Fleischauer is considered by the Examiner to correspond to the Applicant's claimed additional layer. That being said, as discussed above, Fleischauer clearly states that: "the label exhibits a security feature...where unauthorized attempts to remove the label from its destination tears the label at various divisions." (*p. 2, par. 2*). Therefore, the Examiner maintains the position that Fleischauer teaches that the label structure, interpreted to include retroreflective layer (7), ink layers (8 a,b), information layer (3), intermediate layer (4), scratch-off layer (2), and protective layer (6), when tampered tears along various regions, and therefore the additional layer has at least a partial adhesive strength that is greater for the scratch-off label than the base substrate.

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Regardless of whether or not intermediate layer (4) is present, the additional layer, as interpreted by the Examiner, will tear along divisions if the entire label structure is tampered with, and thus has an adhesive strength greater from the scratch label than the base substrate at least in partial areas.

Therefore, the Examiner maintains the rejections of **Claims 1, 4-8, 23, 25-28 under 35 U.S.C. 102(b)** as anticipated by Fleischauer.

22. Regarding the rejection(s) of Claims 3, 6, and 10-11 under 35 USC 103(a) as obvious over Annacone; Claims 13-30 and 30-32 under 35 USC 103(a) as obvious over Annacone or Fleischauer in view of Pekko; Claims 22 and 33 under 35 USC 103(a) as obvious over Annacone in view of Feilen; Claim 3 under 35 USC 103(a) as obvious over Fleischauer; and Claims 2, and 9-10 under 35 USC 103(a) under Fleischauer in view of Annacone:

Applicant argues that because Annacone and Fleischauer each fail to anticipate Applicant's independently claimed invention, one of ordinary skill would not understand how to modify the scratch labels taught by each of Annacone and Fleischauer.

In view of the above clarified rejections and response to Applicant's arguments, the Examiner considers Applicant's arguments moot and maintains these rejections.

### ***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL C. INYARD whose telephone number is (571) 270-1245. The examiner can normally be reached on Monday - Thursday 8:00 AM - 5:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794

APRIL C INYARD /A. C. I./  
Examiner, Art Unit 1794